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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/876,504 | 06/07/2001 | Philip H. Burrus IV | EN11309 | 9312 |

7590 09/03/2004
Motorola Energy Systems Group
Intellectual Property
1700 Belle Meade Court
Lawrenceville, GA 30043

EXAMINER

LAstra, DANIEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,504

Applicant(s)

BURRUS, PHILIP H.

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 have been examined. Application 09/876,504 (ELECTRONIC COUPON AND CUSTOMER DATA ACQUISITION APPARATUS AND METHOD) has a filing date 06/07/2001.

Response to Amendment

2. In response to Office Action dated 03/15/04, the Applicant amended claims 1-6, 10 and cancel claim 5. Applicant amendment overcame the Section 112 rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al (U.S. 6,450,407).

As per claim 1, Freeman teaches:

An electronic savings system, the system comprising:

a portable electronic device having unique personal identification data stored therein (see column 12, lines 17-22; column 14, lines 35-47; column 12, lines 3-9) and;

a means of transmitting the unique personal identification data to a store;
wherein when the store receives the unique personal identification data, a store

discount is applied to a plurality of specially marked store discounted items (see column 12, lines 3-22; column 11, lines 9-12; column 13, lines 35-65; column 14, lines 35-38).

As per claim 2, Freeman teaches:

The system of claim 1, further comprising *a simulated credit card swipe coupled to the portable electronic device* (see figure 2, item 116; column 19, lines 15-25; column 7, lines 7-38; column 12, lines 5-37; column 8, lines 21-35; column 10, lines 23-32).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3, 4 and 6-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (U.S. 6,450,407) in view of Swartz et al (U.S. 6,243,447).

As per claim 3, Freeman teaches:

The system of claim 1, wherein the portable electronic device *comprises a cellular telephone* (see column 8, lines 20-35; column 10, lines 15-32). Freeman fails to teach that *the unique personal identification data comprises a user's telephone number*. However, Swartz teaches a self-checkout system where customers use their cellular phones to make transactions and to transmit customers' identification by transmitting the cellular phone number (see column 3, lines 16-45; column 7, lines 10-17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Freeman system would permit customers to

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use their cellular phones to make transactions and to transmits customers' identification, as taught by Swartz. This feature would eliminate the need for customers to manually enter the customers' identification at the point of sale terminal, therefore reducing the time needed to calculate the discounts based upon the customers' previous shopping history.

As per claim 4, Freeman teaches:

The system of claim 3 wherein the *universal savings system comprises a discount card associated with a particular store* (see column 10, lines 50-65).

As per claim 6, Freeman teaches:

A method of acquiring customer data, the method comprising the steps of:

- a. providing a portable electronic device having unique personal identification data stored within, wherein the portable electronic device comprises a means of transmitting the unique personal identification data (see column 14, lines 35-50; column 16, lines 5-24);
- b. providing a store register capable of receiving the unique personal identification data (see column 8, lines 21-34; column 10, lines 15-31);
- c. transmitting the unique personal identification data from the portable electronic device to the store register (see column 10, lines 15-31; column 16, lines 20-25); and
- d. Freeman fails to teach *applying a store discount to the price of all specially marked, store discounted items* upon receipt of the unique personal identification data. However, Swartz teaches a system that applies a store discount to the price of all store

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discounted items upon receipt of the unique personal identification data (see column 3, lines 40-67; column 7, lines 10-17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Freeman would apply discounts to all marked items, as taught by Swartz and would use the customers' identification obtained from the cellular phone to customize the discounts. This feature would save time and money, as customers would use their cellular phones to make transactions and obtain automatic rebates.

As per claim 7, Freeman teaches:

The method of claim 6, further comprising the steps of:

- a. providing a central computer (see figure 1);
- b. transmitting the unique personal identification data to the central computer (see column 14, lines 35-50; column 16, lines 5-15) and
- c. cross referencing the unique personal identification data with a stored data profile (see column 13, lines 44-55).

As per claim 8, Freeman teaches:

The method of claim 7, further comprising the steps of:

- a. transmitting product data from the store register to the central computer (see column 14, line 64 – column 15, line 12); and
- b. storing the product data with a cross-reference to the unique personal identification data (see column 14, lines 64 - column 15, line 15).

As per claim 9, Freeman teaches:

The method of claim 7, wherein the product data is used for inventory management (see column 15, lines 1-12).

As per claim 10, Freeman teaches:

A method of acquiring customer data, the method comprising the steps of:

a. providing a store register capable having unique store identification data stored within, wherein the store register comprises a means of transmitting the unique store identification data (see column 7, lines 7-38);

b. providing a personal electronic device capable of receiving the unique store identification data (see column 10, lines 15-33);

c. transmitting the unique store identification data from the store register to the portable electronic device (see column 7, lines 7-38); and

d. Freeman fails to teach *applying a store discount to the price of all specially marked, store discounted items* upon successful transmission of the unique store identification data. However, the same rejection applied to claim 6 is applied to claim 10.

As per claim 11, Freeman teaches:

The method of claim 10, further comprising the steps of:

a. transmitting the unique store identification data from the personal electronic device to a remote computer (see column 14, line 35 – column 15, line 12);

b. transmitting customer data from the personal electronic device to a remote computer (see column 14, line 35 – column 15, line 12); and

c. transmitting product data from the personal electronic device to a remote computer (see column 7, lines 8-37; column 10, lines 15-33).

As per claim 12, Freeman teaches:

The method of claim 11, further comprising the steps of:

- a. processing the unique store identification data, the customer data and the product data (see column 7, lines 7-38; column 14, line 35 – column 15, line 12); and
- b. producing a report with the unique store identification data, the customer data and the product data listed in an organized format (see column 14, line 64 – column 15, line 12).

As per claim 13, Freeman teaches:

The method of claim 12, wherein the personal electronic device comprises a cellular telephone (see column 8, lines 20-34; column 10, lines 15-33).

As per claim 14, Freeman teaches:

The method of claim 13, wherein the store register is linked to at least one other store register via a network (see figure 1).

As per claim 15, Freeman teaches:

The method of claim 14, further comprising the step of distributing advertising literature based upon the report (see column 14, line 63 – column 15, line 12).

As per claim 16, Freeman teaches:

The method of claim 14, further comprising the step of using the report for inventory management (see column 14, line 63 – column 15, line 12).

Response to Arguments

5. Applicant's arguments with respect to claims 1-4 and 6-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

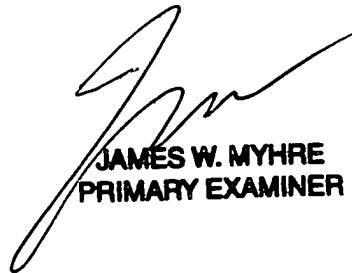
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
August 30, 2004



JAMES W. MYHRE
PRIMARY EXAMINER